

Amendments to the Drawings:

The attached sheets of drawings include changes to Figures 1, 2, 3 and an additional drawing sheet to include every feature of the invention specified in the claims in accordance with 37 C.F.R. § 1.83(a). Figure 1 has been revised to include the predrilled holes. Figure 2 has been revised to include the Z bar and a more clear representation of the L-angle bracket. Figure 3 has been revised to include cross sectional shading. Figure 4 has been added to show a bar extending vertically across the louvers and Figure 5 has been added to show a winding crank mechanism.

Upon approval of the revisions to the informal drawings by the Examiner, Applicant will provide formal drawings.

Attachment: Replacement sheets
Annotated Sheets Showing Changes

REMARKS/ARGUMENTS

Reconsideration of the present application is respectfully requested in light of the following remarks, which are responsive to the Office Action mailed October 12, 2004.

In the specification, the Title and Abstract have been amended to correct informalities.

Claims 1-45 remain in this application.

Claims Rejected Under 35 U.S.C. § 112:

The Examiner has rejected claims 1-45 under 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claims 1, 3, 4, 8, 9, 11, 12, 13, 15, 21, 23, 24, 28, 29, 38, 40, 41, and 42 to further clarify the subject matter which applicant regards as the invention.

Claims Rejected Under 35 U.S.C. § 102(b):

The Examiner has rejected Claims 1, 2, 4, 5, 7, 8, 14, 18, 19, 21, 22, 24, 25, 27, 28, 35, and 36 under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 2,820,259 to *Zveibil*. Applicant respectfully transverges this rejection on the basis that each and every element of Applicant's claimed invention is not present in the *Zveibil* patent. The *Zveibil* patent does not contain each and every element of even the broadest claims of the Applicant's invention and, therefore, does not anticipate Applicant's invention under 35 U.S.C. § 102 (b).

I. *Zveibil* DOES NOT DISCLOSE A SHUTTER COMPRISED OF MATERIAL RESISTANT TO HURRICANE FORCE WINDS

The *Zveibil* patent does not disclose a shutter wherein said outer frame and the louvers are made out of a material resistant to hurricane force winds. *Zveibil* discloses a metal frame. Col. 2, lines 1-3. *Zveibil* does not teach use of metal for the louvers. Not all metals are resistant to hurricane force winds. In fact, *Zveibil* does not mention the ability

of the shutter to withstand hurricane force winds. Nor does *Zveibil* teach the material of which the louvers are made. Because *Zveibil* does not disclose louvered shutters made out of material resistant to hurricane force winds or a shutter capable of providing protection against hurricane force winds, as claimed in Applicant's independent claims 1, 21, and 38, *Zveibil* does not anticipate Applicant's invention. *Zveibil* does not disclose each and every aspect of Applicant's invention and cannot be said to anticipate Applicant's invention.

II. *Zveibil* DOES NOT DISCLOSE A SHUTTER THAT IS RESISTANT TO HURRICANE FORCE WINDS

Zveibil does not disclose a shutter that is structurally resistant to hurricane force winds or capable of withstanding hurricane force winds and which contains functional louvers. The shutter disclosed in *Zveibil* is mounted inside the trim of a window. See Col. 1-2, lines 71-2. The Applicant's shutter is mounted over the window of a building such that the shutter overlaps the window. See paragraph 28. Hurricane force winds or strong storm winds would cause the shutter disclosed in *Zveibil* to be pushed against the window, possibly causing damage to the window or breaking through the window. Additionally, the *Zveibil* shutter does not provide for a method to keep louvers in closed position during hurricane force winds. Accordingly, *Zveibil* does not disclose each and every aspect of Applicant's invention, because Applicant's broadest claims include a shutter that provides for protection from hurricane force winds.

Claims Rejected Under 35 U.S.C. § 103(a):

The Examiner has rejected claims 3, 9, 15, 17, 23, 29, 38, 43 and 44 under 35 U.S.C. § 103(a) as being obvious over the *Zveibil* patent in further view of U.S. Patent 1,551,753 to Lane (hereinafter "*Lane*"). The Examiner states that Lane discloses a L shaped operating mechanism 20. Applicant respectfully transgresses this rejection on the basis that the Examiner has failed to establish a prima facie case of obviousness by failing to establish that it would have been obvious to someone skilled in the art to combine the *Zveibil* and *Lane* references. The Examiner has also failed to point out a

teaching, suggestion or incentive supporting the stated combination and none of these factors is inherently found in the references.

The Examiner has also rejected claims 6, 26, 10, 30, 31, 11, 32, 12, 33, 13, 34, 16, 37, 17, 20, 39, 40, and 41 as being obvious over the *Zveibil* patent in further view of various other patents. Applicant transgresses these rejections on the same basis as noted above, specifically, the Examiner has failed to establish a prima facie case of obviousness by failing to show it would have been obvious to someone skilled in the art to combine the references and by failing to point out a teaching, suggestion or incentive supporting the stated combination.

It is well settled that it is the burden of the Examiner to establish a prima facie case of obviousness when rejecting claims under 35 U.S.C. § 103. MPEP § 2142. If a prima facie case of obviousness is not established, a rejection under 35 U.S.C. § 103 is improper and the Applicant need not present evidence of non-obviousness to overcome such a rejection. *Id.* Applicants respectfully submit that the Examiner's rejections do not establish a prima facie case of obviousness and that Claims 3, 6, 9, 10, 11, 12, 13, 15, 16, 17, 20, 23, 26, 29, 30, 31, 32, 33, 34, 37, 38, 39, 40, 41, 43 and 44 are therefore in condition for allowance.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

The pending office action attempts but fails to provide two of the basic criteria (teaching or suggestion to make the claimed combination and teaching or suggestion of all claim limitations) and completely ignores the third criteria (reasonable expectation of success.) Accordingly, a prima facie case of obviousness has not been established.

A. The Examiner has failed to establish that there is a teaching or suggestion to combine *Zveibil* and *Lane*

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

The sole basis cited by the Examiner in support of his conclusion that there is a suggestion to combine *Zveibil* and *Lane* is that it would have been obvious to one of ordinary skill in the art to provide *Zveibil* with an operating mechanism, as taught by *Lane*, to increase the strength of the operating mechanism. A cursory examination of *Zveibil* and *Lane* will quickly disprove the Examiner's conclusion that a suggestion to combine the references would be obvious to one of ordinary skill in the art.

The Examiner has not established that it would have been obvious to someone skilled in the art to combine the *Zveibil* and *Lane* references. The test of whether it would have been obvious to select specific teachings and combine them must still be met by identification of some suggestion, teaching or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention. The Examiner cites to *Lane* for disclosing a L shaped operating mechanism. The Examiner fails to state a teaching, suggestion or motivation to combine the references. Further, none of these references teaches nor suggests a shutter constructed to protect against hurricane force winds. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference...Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." M.P.E.P. 2145 III, citing to *In re Keller*, 642 F.2d 413 (CCPA 1981). The combination of such references would not result or suggest in the Applicant's claimed invention, therefore the Examiner's obviousness rejection must fail.

The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the

teaching or motivation to combine prior art references. A showing of a suggestion, teaching or motivation to combine prior teachings must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. Accordingly, there must be a teaching, suggestion or incentive supporting the stated combination. The Examiner has failed to point out such a particular teaching, suggestion or motivation in the references. The Examiner merely makes broad conclusory statements about what each reference standing alone teaches. This does not amount to a teaching or motivation to combine the references.

This is a far cry from suggesting or providing any motivation for combining the references. The three references provide no suggestion or motivation whatsoever to combine them. Accordingly, the Examiner has failed to meet his burden in connection with the first element of his prima facie case for obviousness.

B. The Examiner has failed to establish that there is a reasonable expectation of success in combining *Zveibil* and *Lane*

As stated above, there is absolutely no suggestion or motivation to combine *Zveibil* and *Lane*. The Examiner has failed to provide any argument, much less the required "convincing line of argument" that there is any reasonable expectation of success in combining the references to achieve the invention claimed by Applicants. In fact, neither of the references teaches of a shutter resistant to hurricane force winds. Accordingly, the Examiner has failed to meet his burden in connection with the second element of his prima facie case for obviousness.

C. The Examiner has failed to establish that *Zveibil* and *Lane* teach or suggest all the limitations of Claim 3, 9, 15, 17, 23, 29, 38, 43, and 44

The Examiner has also failed to establish that the combination of *Zveibil* and *Lane* teach or suggest all of the limitations of Claims 3, 9, 15, 17, 23, 29, 38, 43, and 44 of the present application. Addressing specifically the statements made by the Examiner in this respect, Applicants point out the following:

- (1) The Examiner states that *Zveibil* discloses "a shutter providing storm protection comprising an outer frame 10 formed by a pair of vertical members and

a pair of horizontal members connected to each other and defining an interior area, a plurality of functional horizontal louvers 18 movably connected to said outer frame and substantially filling said interior area of said frame; and wherein said outer frame and said louvers are made out of a hurricane resistant material, i.e. metal, an operating mechanism 32.” At best, *Zveibil* describes a decorative shutter capable of minimal storm protection. Nowhere does *Zveibil* describe a shutter capable of providing protection from hurricane force winds.

(2) The Examiner states that *Lane* discloses “a L shaped operating mechanism 20” and “a Z shaped operating mechanism 20.” *Lane* describes a shutter or window comprised of slats. See column 1, lines 7-9, “[m]y invention related to a window shutter and more particularly to a shutter having transparent slats.” See also, column 1, lines 42-43, “[m]y improved slat 10 in its preferred form as shown in Figures 1 to 4 is made of glass...” The shutter of *Lane* is not designed to withstand hurricane force winds. Moreover, the operating mechanism of *Lane* identified by the Examiner as 20 is an operating bar. See Figure 1 and 2. This is completely different than the L-angle bracket or Z bar used in Applicant’s invention. The L-angle bracket of Applicant’s invention is typically a one inch by one inch bracket in the form of the letter “L”. The louvers of Applicant’s shutter are directly attached to the L-angle bracket, unlike the louvers of *Lane*. Additionally, the Z bar is used in Applicant’s invention as means for holding the shutter against a structure, not as an operating mechanism.

As has been shown above, the limitations of Claims 3, 9, 15, 23, 29, 38, 43, and 44 are neither taught nor suggested by *Zveibil* and *Lane*. Accordingly, the Examiner has failed to meet his burden in connection with the third element of his prima facie case for obviousness.

D. The Examiner has failed to establish that there is a teaching or suggestion to combine *Zveibil* and *Vaida*.

Claims 6 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Zveibil* in further view of *Vaida*. According to the Examiner, it would have been obvious to one having ordinary skill in the art to provide *Zveibil* with a winding crank

operating mechanism 46, as taught by *Vaida*, to increase the ease with which the louvers can be moved.

Similar to the above arguments against the obviousness of the combination of *Zveibil* and *Lane*, the Examiner has failed to establish that it would have been obvious to someone skilled in the art to combine *Zveibil* and *Vaida*. The Examiner cites to *Vaida* for disclosing a winding crank operating mechanism 46. However, the Examiner fails to cite to a teaching, suggestion or motivation to combine the references. Moreover, the combination of such references does not teach aspects of Applicant's invention wherein the shutter provides protection from hurricane force winds and includes functional louvers operated by a winding crank mechanism.

E. The Examiner has failed to establish that there is a teaching or suggestion to combine *Zveibil* and *Yadidya*.

Claims 10, 30, 31 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Zveibil* in further view of *Yadidya*. According to the Examiner, it would have been obvious to one having ordinary skill in the art to provide *Zveibil* with louvers 1 which interlock with each other in a closed position, as taught by *Yadidya*, to prevent air from passing through the shutter.

In addition to the above arguments against the obviousness of the combination of *Zveibil* with various references, the Examiner has failed to establish that it would have been obvious to someone skilled in the art to combine *Zveibil* and *Yadidya*. The Examiner cites to *Yadidya* for disclosing louvers 1 which interlock with each other in a closed position. However, the Examiner fails to cite to a teaching, suggestion or motivation to combine the references. *Yadidya* in fact discloses a roller shutter, which is wound up on a horizontal shaft mounted above the window opening. See column 1, lines 8-11. Roller shutters are designed to protect the room against unauthorized entry and to darken the room at night. See column 1, lines 11-14. The combination of such references does not teach aspects of Applicant's invention of a hurricane force wind resistant shutter where the louvers interlock horizontally with each other when the louvers are in a closed position.

F. The Examiner has failed to establish that there is a teaching or suggestion to combine *Zveibil* and *Arehart et al.*

Claims 11, 17, 32, and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Zveibil* in further view of *Arehart et al.* According to the Examiner, it would have been obvious to one having ordinary skill in the art to provide *Zveibil* with a with an aluminum construction, as taught by *Arehart et al.*, to improve corrosion resistance of the shutter. The Examiner also contends that it would have been obvious to one of ordinary skill in the art to provide *Zveibil* with a holding means, as taught by *Arehart et al.*, to enable a user to fix the shutter to the structure for security purposes.

In addition to the above arguments against the obviousness of the combination of *Zveibil* with various references, the Examiner has failed to establish that it would have been obvious to someone skilled in the art to combine *Zveibil* and *Arehart*. The Examiner cites to *Arehart* for disclosing an aluminum construction and a means for holding a frame against a structure comprising holes and bolts 42. However, the Examiner fails to cite to a teaching, suggestion or motivation to combine the references. The combination of such references does not teach aspects of Applicant's invention of a hurricane force wind resistant shutter with functional louvers and which is made of aluminum. Nor does the combination teach a hurricane force wind resistant shutter with functional louvers wherein means for holding the shutter against the window or opening are predrilled holes through an outer frame which are anchored by bolts to a structure near the window.

G. The Examiner has failed to establish that there is a teaching or suggestion to combine *Zveibil* and *Astrisky*

Claims 12, 33 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Zveibil* in further view of *Astrisky*. According to the Examiner, it would have been obvious to one having ordinary skill in the art to provide *Zveibil* with a polycarbonate 87 for storm protection, as taught by *Astrisky*, to increase the durability of the shutter.

In addition to the above arguments against the obviousness of the combination of *Zveibil* with various references, the Examiner has failed to establish that it would have

been obvious to someone skilled in the art to combine *Zveibil* and *Astrisky*. The Examiner cites to *Astrisky* for disclosing the use of polycarbonate 87 for storm protection. However, the Examiner fails to cite to a teaching, suggestion or motivation to combine the references. *Astrisky* teaches a shutter composed of two door like members which are each solid in construction. See column 1, lines 66-67. *Astrisky* does not teach the use of polycarbonate on louvered hurricane shutters, something which none of the references teach. The combination of such references does not teach aspects of Applicant's invention directed to a functional louvered hurricane shutter that is resistant to hurricane force winds.

H. The Examiner has failed to establish that there is a teaching or suggestion to combine *Zveibil* and *Patberg et al.*

Claims 13, 34 and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Zveibil* in further view of *Patberg et al.* According to the Examiner, it would have been obvious to one having ordinary skill in the art to provide *Zveibil* with a high density foam plastic, as taught by *Patberg*, to increase the impact resistance of the shutter.

In addition to the above arguments against the obviousness of the combination of *Zveibil* with various references, the Examiner has failed to establish that it would have been obvious to someone skilled in the art to combine *Zveibil* and *Patberg*. The Examiner cites to *Patberg* for disclosing the use of high density foam plastic. However, the Examiner fails to cite to a teaching, suggestion or motivation to combine the references. In fact, *Patberg* teaches an anti-intrusion beam for incorporating into a vehicle door assembly. The combination of such references does not teach aspects of Applicant's invention directed to use of high density plastic with foam reinforcement in the louvers or frame of a shutter that is resistant to hurricane force wind.

I. The Examiner has failed to establish that there is a teaching or suggestion to combine *Zveibil* and *Kramer*

Claim 20 and 45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Zveibil* in further view of *Kramer*. According to the Examiner, it would have been

obvious to one having ordinary skill in the art to provide *Zveibil* with a telescoping arm, as taught by *Kramer*, to enable a user to position the shutter in a plurality of positions pivoted away from the structure.

In addition to the above arguments against the obviousness of the combination of *Zveibil* with various references, the Examiner has failed to establish that it would have been obvious to someone skilled in the art to combine *Zveibil* and *Kramer*. The Examiner cites to *Kramer* for disclosing telescoping means for holding a lower horizontal member comprising a telescoping arm 15. However, the Examiner fails to cite to a teaching, suggestion or motivation to combine the references. The combination of such references does not teach aspects of Applicant's invention of a functional louvered hurricane force wind resistant shutter that includes a telescoping arm.

For the foregoing reasons, Applicant respectfully requests that the Examiner's rejections be withdrawn and all claims in the subject application be permitted to proceed to allowance.

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Respectfully submitted,

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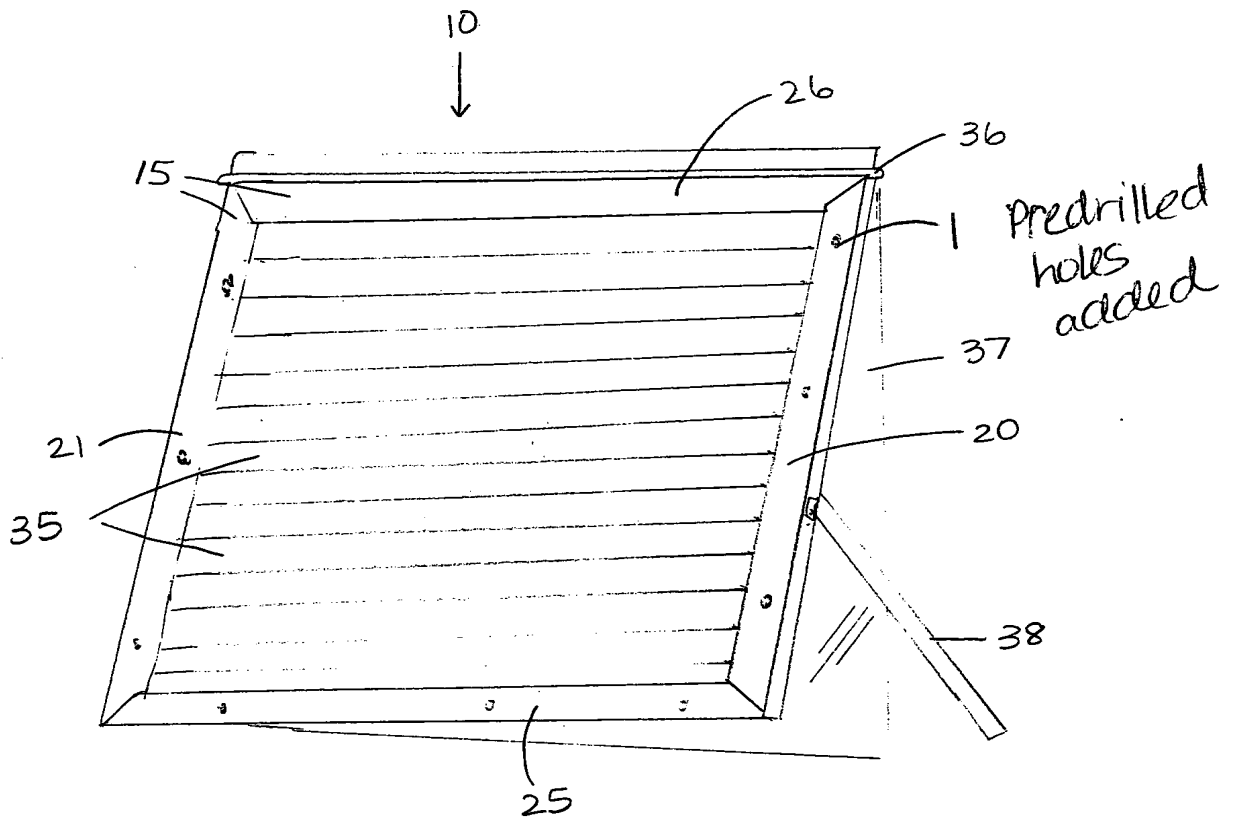
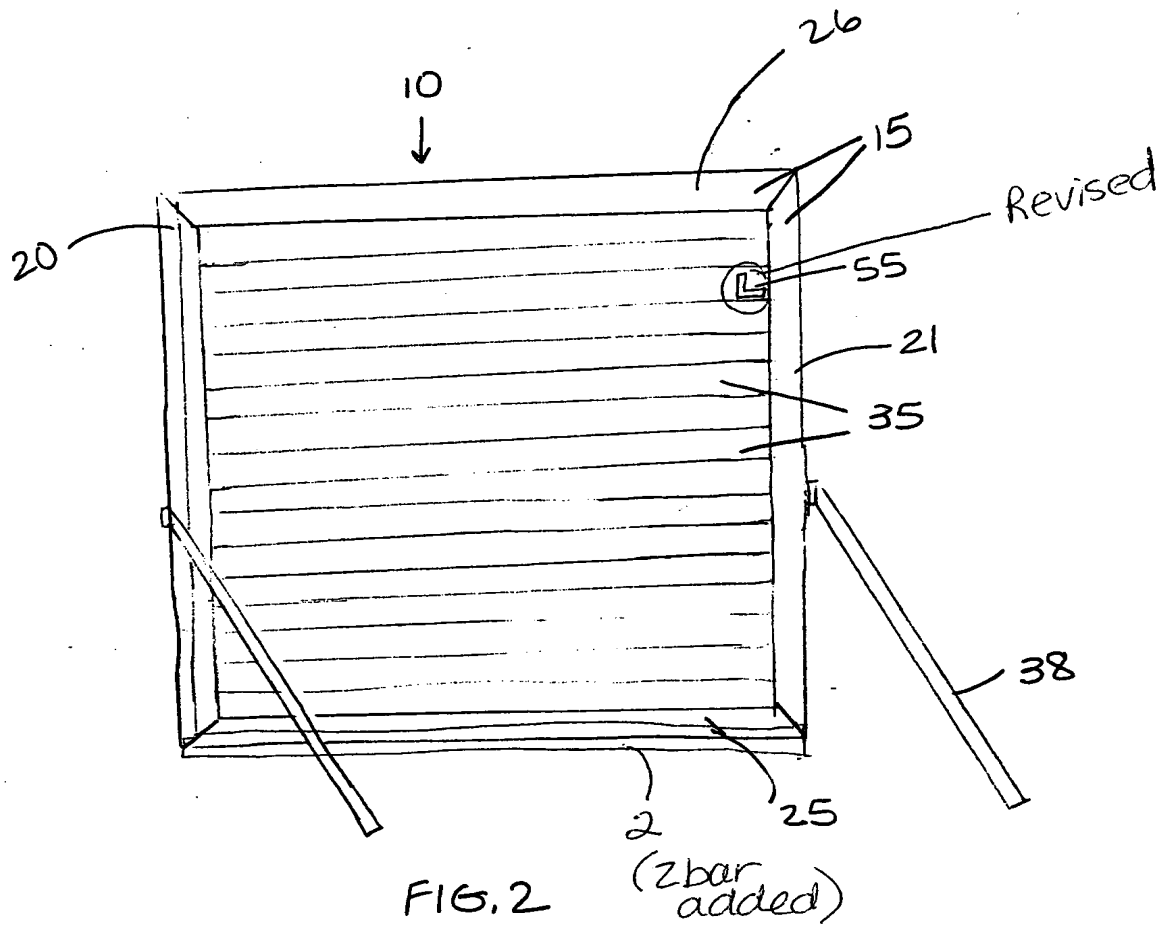


FIG. 1



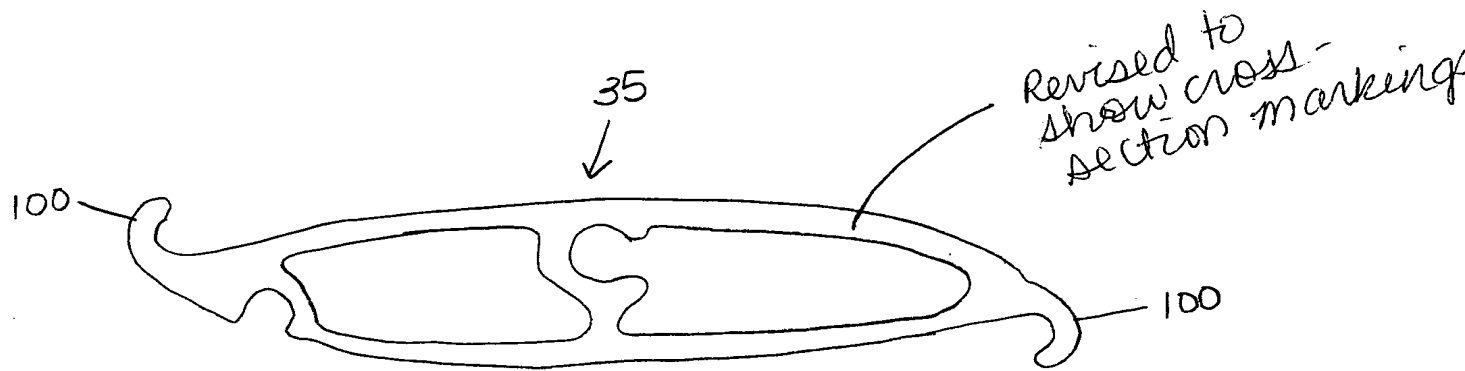


FIG. 3